

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86406349
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION	
MARK FILE NAME	https://tmng-al.uspto.gov/resting2/api/img/86406349/large
LITERAL ELEMENT	EXCLUSIVE EASY WASH FORMULA
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
ARGUMENT(S)	
<p>The Examining Attorney has refused the subject application based on an allegation that the mark fails to function as a trademark to indicate the source of the goods and to identify and distinguish them from others. Applicant respectfully disagrees.</p> <p><i>The Wording in Not Commonly Used Throughout Applicant's Industry</i></p> <p>The subject mark is comprised of the wording "EXCLUSIVE EASY WASH FORMULA" with a curved line at the top and bottom of the mark, creating an incomplete circle around the wording. The disclaimer of the one term "FORMULA" does not render the entire mark descriptive. Applicant offers that when the mark is viewed as a whole with the design element, it does not readily convey a common use throughout Applicant's industry. The mark when viewed as a whole creates a composite mark that is not merely descriptive of the subject goods.</p> <p><i>Applicant's Mark is Placed on Point-of-Sale Displays in Association with Applied-For Goods</i></p> <p>The placement of Applicant's mark is not in an area where informational matter is commonly placed. Nonetheless, Applicant submits a substitute use specimen showing the applied-for mark on a point-of-sale display in association with applied-for goods (See Exhibit A: Image of Mark Affixed to Point-of-Sale Display and Exhibit B: Declaration of Substitute Specimen). With the substitute use specimen, the placement of the mark is undoubtedly in a manner to function as a trademark and would not be considered informational matter.</p> <p>According to the Board in <i>In re Bright of America, Inc.</i> "a display associated with the goods comprises essentially point-of-sale material such as banners, shelf-talkers, window displays, menus, or similar devices which are designed to catch the attention of purchasers and prospective purchasers as an inducement to consummate a sale and which prominently display the mark in question and associate it or relate it to the goods in such a way that an association of the two is inevitable even though the goods may not be placed in close proximity to the display [...]." See 205 USPQ 63 (TTAB 1979). Here, the substitute specimen shows that the mark is displayed in close proximity to the product. The mark is affixed to a point-of-sale presentation that is conspicuously and immediately adjacent to a paint can. Moreover, this presentation appears on a store counter. The trademark is nearly half the size as the paint can and is displayed in a manner that captures the attention of consumers who are seeking out paint products or prospective consumers who are merely walking by. The association between the mark and the goods is inevitable. Applicant's substitute specimen shows proper use of the applied-for mark as a trademark.</p> <p>Applicant respectfully requests that the Examining Attorney withdraw her refusal and allow the application to proceed on the Supplemental Register.</p>	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
JPG FILE(S)	\\TICRS\EXPORT17\IMAGEOUT 17\864\063\86406349\xml1\RFR0002.JPG
ORIGINAL PDF FILE	evi_21622320150-20161031181258810560_ . Exhibit B - Declaration of Substitute Specimen.pdf
CONVERTED PDF FILE(S)	\\TICRS\EXPORT17\IMAGEOUT17\864\063\86406349\xml1\RFR0003.JPG

(1 page)	
DESCRIPTION OF EVIDENCE FILE	Exhibit A: Image of Mark Affixed to Point-of-Sale Display; and Exhibit B: Declaration of Substitute Specimen
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	002
DESCRIPTION	
Coating compositions in the nature of paints and stains for architectural applications	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/00/2014
FIRST USE IN COMMERCE DATE	At least as early as 04/00/2015
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	002
DESCRIPTION	
Coating compositions in the nature of paints and stains for architectural applications	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/00/2014
FIRST USE IN COMMERCE DATE	At least as early as 04/00/2015
STATEMENT TYPE	"The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application" [for an application based on Section 1(a), Use in Commerce] OR "The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use" [for an application based on Section 1(b) Intent-to-Use]. OR "The attached specimen is a true copy of the specimen that was originally submitted with the application, amendment to allege use, or statement of use" [for an illegible specimen].
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT17\IMAGEOUT 17\864\063\86406349\xml1\ RFR0004.JPG
SPECIMEN DESCRIPTION	Image of Mark Affixed to Point-of-Sale Display
SIGNATURE SECTION	
ORIGINAL PDF FILE	HS_21622320150-181258810_ . Exhibit B - Declaration of Substitute Specimen.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT17\IMAGEOUT17\864\063\86406349\xml1\RFR0005.JPG
SIGNATORY'S NAME	Rita Bergstrom
SIGNATORY'S POSITION	Assistant Secretary
RESPONSE SIGNATURE	/dp/
SIGNATORY'S NAME	Dennis S. Pahl
SIGNATORY'S POSITION	Attorney of Record, NY bar member
SIGNATORY'S PHONE NUMBER	212-708-1817
DATE SIGNED	10/31/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION	
SUBMIT DATE	Mon Oct 31 18:26:07 EDT 2016
TEAS STAMP	USPTO/RFR-XXX.XXX.XXX.XX- 20161031182607582711-8640 6349-5709495324b91fb8d8d5 6fe76dbabbde1a558d837ed60 f6b04de0528c39798adfc-N/A -N/A-20161031181258810560

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PTO Form 1960 (Rev 10/2011)
OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86406349** EXCLUSIVE EASY WASH FORMULA (Stylized and/or with Design, see <https://tmng-al.uspto.gov/resting2/api/img/86406349/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Examining Attorney has refused the subject application based on an allegation that the mark fails to function as a trademark to indicate the source of the goods and to identify and distinguish them from others. Applicant respectfully disagrees.

The Wording in Not Commonly Used Throughout Applicant's Industry

The subject mark is comprised of the wording "EXCLUSIVE EASY WASH FORMULA" with a curved line at the top and bottom of the mark, creating an incomplete circle around the wording. The disclaimer of the one term "FORMULA" does not render the entire mark descriptive. Applicant offers that when the mark is viewed as a whole with the design element, it does not readily convey a common use throughout Applicant's industry. The mark when viewed as a whole creates a composite mark that is not merely descriptive of the subject goods.

Applicant's Mark is Placed on Point-of-Sale Displays in Association with Applied-For Goods

The placement of Applicant's mark is not in an area where informational matter is commonly placed. Nonetheless, Applicant submits a substitute use specimen showing the applied-for mark on a point-of-sale display in association with applied-for goods (See **Exhibit A**: Image of Mark Affixed to Point-of-Sale Display and **Exhibit B**: Declaration of Substitute Specimen). With the substitute use specimen, the placement of the mark is undoubtedly in a manner to function as a trademark and would not be considered informational matter.

According to the Board in *In re Bright of America, Inc.* "a display associated with the goods comprises essentially point-of-sale material such as banners, shelf-talkers, window displays, menus, or similar devices which are designed to catch the attention of purchasers and prospective purchasers as an inducement to consummate a sale and which prominently display the mark in question and associate it or relate it to the goods in such a way that an association of the two is inevitable even though the goods may not be placed in close proximity to the display [...]." See 205 USPQ 63 (TTAB 1979). Here, the substitute specimen shows that the mark is displayed in close proximity to the product. The mark is affixed to a point-of-sale presentation that is conspicuously and immediately adjacent to a paint can. Moreover, this presentation appears on a store counter. The trademark is nearly half the size as the paint can and is displayed in a manner that captures the attention of consumers who are seeking out paint products or prospective consumers who are merely walking by. The association between the mark and the goods is inevitable. Applicant's substitute specimen shows proper use of the applied-for mark as a trademark.

Applicant respectfully requests that the Examining Attorney withdraw her refusal and allow the application to proceed on the Supplemental Register.

EVIDENCE

Evidence in the nature of Exhibit A: Image of Mark Affixed to Point-of-Sale Display; and Exhibit B: Declaration of Substitute Specimen has been attached.

JPG file(s):

[Evidence-1](#)

Original PDF file:

[evi_21622320150-20161031181258810560 . Exhibit B - Declaration of Substitute Specimen.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 002 for Coating compositions in the nature of paints and stains for architectural applications

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/00/2014 and first used in commerce at least as early as 04/00/2015 , and is now in use in such commerce.

Proposed: Class 002 for Coating compositions in the nature of paints and stains for architectural applications

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/00/2014 and first used in commerce at least as early as 04/00/2015 , and is now in use in such commerce. Applicant hereby submits one(or more) specimen(s) for Class 002 . The specimen(s) submitted consists of Image of Mark Affixed to Point-of-Sale Display .

"The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application" *[for an application based on Section 1(a), Use in Commerce]* OR "The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use" *[for an application based on Section 1(b) Intent-to-Use]*. OR "The attached specimen is a true copy of the specimen that was originally submitted with the application, amendment to allege use, or statement of use" *[for an illegible specimen]*. [Specimen File1](#)

SIGNATURE(S)

Declaration Signature

Original PDF file:

[HS_21622320150-181258810 . Exhibit B - Declaration of Substitute Specimen.pdf](#)

Converted PDF file(s) (1 page)

[Signature File1](#)

Signatory's Name: Rita Bergstrom

Signatory's Position: Assistant Secretary

Request for Reconsideration Signature

Signature: /dp/ Date: 10/31/2016

Signatory's Name: Dennis S. Pahl

Signatory's Position: Attorney of Record, NY bar member

Signatory's Phone Number: 212-708-1817

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86406349

Internet Transmission Date: Mon Oct 31 18:26:07 EDT 2016

TEAS Stamp: USPTO/RFR-XXX.XXX.XXX.XX-201610311826075

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dbabbde1a558d837ed60f6b04de0528c39798adf

c-N/A-N/A-20161031181258810560



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: PPG Architectural Finishes, Inc.

Serial No.: 86/406,349



Trademark:

Law Office: 102

Examiner: Tara L. Bhupathi

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

DECLARATION IN SUPPORT OF SUBSTITUTE SPECIMEN

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or document or any registration resulting therefrom, declares as follows:

- (a) That all statements made on his/her own knowledge are true and that all statements made on information and belief are believed to be true and that he/she is properly authorized to execute this Declaration on behalf of Applicant; and
- (b) That he/she believes Applicant to be the owner of the trademark sought to be registered; and
- (c) Applicant is using the mark in commerce on or in connection with all of the goods identified in the application; and
- (d) That the specimen(s) attached hereto was/were in use in commerce in connection with all goods stated in the said application since as early as 04/00/2015 and that the specimen(s) represent(s) the mark as actually used by applicant at the aforesaid time.

Signature

Rita Bergstrom
Name

Assistant Secretary
Title

October 31, 2016
Date



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: PPG Architectural Finishes, Inc.

Serial No.: 86/406,349



Trademark:

Law Office: 102

Examiner: Tara L. Bhupathi

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- (a) That all statements made on his/her own knowledge are true and that all statements made on information and belief are believed to be true and that he/she is properly authorized to execute this Declaration on behalf of Applicant; and
- (b) That he/she believes Applicant to be the owner of the trademark sought to be registered; and
- (c) Applicant is using the mark in commerce on or in connection with all of the goods identified in the application; and
- (d) That the specimen(s) attached hereto was/were in use in commerce in connection with all goods stated in the said application since as early as 04/00/2015 and that the specimen(s) represent(s) the mark as actually used by applicant at the aforesaid time.

Signature

Rita Bergstrom
Name

Assistant Secretary
Title

October 31, 2016
Date